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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/791,430

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EXAMINER

ALIE, GHASSEM

ART UNIT

PAPER NUMBER

3724

MAIL DATE

DELIVERY MODE

11/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/791,430

Applicant(s)

MAGNUSON ET AL.

Examiner

Ghassem Alie

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/27/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41, 43, 44 and 46-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41, 43, 44 and 46-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Specification

1. The amendment filed 05/03/06 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: added Figs. 6 and 7 and its description on paragraphs 18-20 in specification are not supported by the original disclosure. The original disclosure fails to teach the exact location of the brake release handle on a chain saw. The original disclosure fails to teach a chain saw that looks like the chain saw in Figs. 6-7. The original disclosure also fails to teach that the brake release handle is simply connected to the exterior of the housing of the chain saw by a single screw, as shown in Figs. 6-7. It should be noted that a brake release handle should pivotally engage the brake mechanism within the housing of the chain saw such as shown in Schurr (4,683,660). The original disclosure also does not teach that the light source illuminate the chain saw in a manner as shown in Fig. 6. Fig. 6 shows that the light beams overlapped in a manner that the middle beam project further behind the upper and lower beams in front of the chain saw machine. This has not been disclosed in the original disclosure. In addition, it is not clear how the brake lever can function, if securing means or fastening means simply secures the brake lever to the exterior of the housing. Applicant argued that the original specification teaches that the chain saw in Schurr (4,683,660) is an appropriate example for such a chain saw assembly that could be modified to have a light source. Therefore, it is suggested that the chain saw in Schurr to be used as an exemplary view of the chain saw that has a light source as described

in the instant application. In this case, the brake lever in the instant application could replace the brake lever in Schurr.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

Obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patent ability shall not be negative by the manner in which the invention was made.

3. Claims 41, 43-44, 46-51, and 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Casas (2002/0054491 A1) in view of Overy et al. (4,335,514), hereinafter Overy, and in further view of Richards et al. ((2004,0050188), hereinafter Richards.

Regarding claim 41, Casas teaches a motor chain saw 4 having a handle or a handguard attached to the housing of the motor chain saw 4. Casas also teaches that the handguard or handle having a front wall and a rear wall and a light source 6. See Fig. 3 and paragraph 19 in Casas. Casas also teaches that the light source 6 is secured to the handguard or handle and is adapted to emanate from the front wall. It should be noted that the light source 6 is a part of the front wall of the handle or handguard.

Casas does not explicitly teach that the handle or handguard is also a brake release handle that operatively is connected to a braking mechanism and the front wall includes a translucent material or plexiglass.

However, Overy teaches that a handguard, similar to the handguard shown in Casas, which is part of a braking mechanism. Overy teaches a braking mechanism 34 that includes a brake lever 36 which is also a handguard 40 and is located in front of a front handle 42. See

Figs. 1-5 and col. 2, lines 9-56 in Overy. It should be noted that the brake lever 36 in Overy also includes an upper portion that is handguard 40 and is located in front of the front handle, the same place that the handguard with a light source is located in Casas. Therefore, it would have been obvious to a person of ordinary skill in the art to use the handguard in Casas' chain saw also as a brake release that is connected to a braking mechanism, as taught by Overy, in order to pivot the handguard and stop the rotation of the saw chain when is desired.

Casas, as modified above, does not explicitly teach that the light source has a cover or a front wall that includes a translucent material or plexiglass. However, the use of translucent material or plexiglass with a light source in tools is well known in the art such as taught in Richards. Richards teaches a light source 30 includes a front wall or a cover 62 that comprises of a translucent or transparent material such as plexiglass, glass, polycarbonate, or another type of translucent or transparent material. It should also be noted that the light source 30 is located within the handle 17, 18. See Figs. 1-3 and paragraph 27 in Richards. It would have been obvious to a person of ordinary skill in the art to provide the light source in Casas' chain saw, as modified by Overy, with the translucent cover or front wall that includes plexiglass, as taught by Richards, in order to cover the light source with translucent or transparent material that emanate the light and protects the light source.

Regarding claims 43-44 and 46 Casas, as modified by Richards, teaches everything noted above including that the front wall is a cover 62 that reversibly is attached to the brake release handle. It should be noted that the cover 62 can be revered and attached to the handle. See Fig. 1 Richards. In addition, in addition to the degree that it could be argued that the cover 62 cannot be revered, an Official Notice is taken that the use of reversible cover for a

light source is well known in the art. Casas, as modified by Richards, also teaches that the translucent material 62 is plastic. It should be noted that the plexiglass is a trademark for thermoplastic poly (methylemethacrylate) type polymers which considered to be plastic. See col. 7, lines 25-35 in Budde et al. (4,774,637). Casas, as modified by Richards, also teaches that the translucent material is glass.

Regarding claims 47, 48, and 50, Casas, as modified by Overy, teaches that the light source mounting means or a plate 10 is affixed to the brake release. Casas does not explicitly teach that the plate is located within the brake release handle and is attached to an interior surface of the rear wall. However, Richards teaches that the light source 30 is affixed to a plate attached to a rear wall 56 and is located within the handle. It should be noted that the rear plate that holds LEDs attached to the interior surface of the rear wall 56. It should be also noted that the handle 18 includes an upper portion 17 that also considered being a portion of the handle. See Fig. 3 in Richards. It should have been obvious to a person of ordinary skill in the art to attached the plate of the light source in Casas' chain saw, as modified by Overy, to an interior surface of the rear wall in the handle, as taught by Richards, since the light source works the same whether it is attached to the front wall or the rear wall of the release handle, and in both cases light emanates from the front wall of the handle. There is no criticality in the manner that the light source is attached to the handle. The light source functions in the same manner whether is attached to an interior surface of the rear wall or in front on the front wall.

Regarding claims 54-56, Cases, as modified by Overy, teaches everything noted above except that the brake release handle further includes a switch for activating the light source

and the switch is located in the rear wall. However, Richards teaches that a switch 70 attached to the rear wall 17 of the handle for activating the light source. See Fig. 3 and paragraph 46 in Richards. It should have been obvious to a person of ordinary skill in the art to provide Casas' chain saw, as modified by Overy, with a switch, as taught by Richards, in order to easily access the activation switch of the light source and activate the light source when is needed.

4. Claims 52 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Casas in view of Overy and Richards, as applied to claim 49, and in further view Of Kopras et al. (6,443,675), hereinafter Kopras. Regarding claims 52 and 53, Casas, as modified above, does not teach explicitly that the light source includes two or more light emitting diodes. However, the use of two or more light emitting diodes to illuminate a front area of a cutting tool is well known in the art such as taught by Kopras. Kopras teaches a hand-held cutting tool 20 including a light source 130 for illuminating the front area of the cutting tool. Kopras also teaches that the light source includes two or more light emitting diodes. See Fig. 11 and col. 18, lines 26-67 in Kopras. It would have been obvious to a person of ordinary skill in the art to provide the light source in Casas' chain saw, as modified above, with light emitting diodes, as taught by Kopras, in order to improve the visibility of the workpiece at the point of a cut being made.

Response to Amendment

5. Applicant's argument that the drawings should not be objected since a motor chain saw as set forth in claim 41 is well known in the art such as the chain saw described in Schurr (4,683,660) is not persuasive. As stated in the pervious Office Action, drawings must show

every feature of the invention specified in the claims. In this case, a motor chain saw set forth in claim 41 must be shown. As stated above, it is suggested that the chain saw in Schurr to be used as an exemplary view of the chain saw that has a light source as described in the instant application. In this case, the brake lever in the instant application could replace the brake lever in Schurr. Applicant's argument that the engineering of a chain saw handle for a particular chain saw is well within the capability of one of ordinary skill in the art is not persuasive. The particular handle in the present invention has not been shown to be placed on a chain saw. Applicant claims a chain saw that includes a particular handle. Therefore, it must be shown that the handle is mounted on a chain saw without introducing new matter into the disclosure.

Applicant's argument that there is no teaching to internalize a light within a brake release handle is not persuasive. Firstly, as stated in the rejection of claims 1 (item 5, lines 8-9 in the previous Office action and item 3, lines 9-10 in this Office action) "the light source 6 is a part of the front wall of the handle or handguard." In this case, the housing of the light bulb and the cover in front of the light bulb also is considered to be a part of the handguard or the brake release handle. Therefore, the light bulb within the housing is located at least within and the handguard/ brake release handle. It should be noted that claims neither recite the shape and structure of the front wall nor the external or internal structure of the brake handle release. Therefore, as stated above, the light source housing is considered to be a part of the segmented front wall, and a light bulb (which is inherently a light source) is located within the front wall or the handguard/ handle brake release. The light is adapted to emanate from the portion of the front wall that is the housing of the light source 6. In addition, at least

a couple of wires extend from the light bulb inside a recess or an aperture in the handle. The wires are also considered to be part of the light source. In this case, the wires, which are a part of the light source, are within the handguard or the hand release handle. Casas does not explicitly teach that the portion of the front wall in front of the light within the casing includes a translucent material. However, Richards teaches that the use of translucent material in front of a light or with the front wall of a light source is old and well known in the art. Therefore, applicant's assertion that Cases in combination with Overy does not teach a light secured within the brake release handle is incorrect. It should be noted that the claims should be amended in a manner that also read over the apparatus disclosed by Didato (5,863,112). Didato which was recited in the previous Office action teaches that the light could be disposed entirely within a brake release handle.

Secondly, Casas in view of Overy teach a light source secured to a brake release handle. Casas in view of Overy does not explicitly teach that the entire light source is within the handguard or brake release handle in a manner that the cover of the light source 6 or the distal end of the light source is flushed with the external surface of the light source. It should be noted that the limitation mentioned above has not been claimed. However, Richards, which is combined with Casas and Overy, clearly teaches that the light source is entirely located within a handle 17, 18 and the translucent cover is flushed with the front wall of the housing or the handle 17, 18. In other words, Casas in combination with Overy and Richards teaches that the light bulb or light source is secured entirely within the handle or brake release handle. It should also be noted that methods of securing a light source either entirely within the handle, partially within the handle, or on the handle are art-recognized equivalent

which produce the same result. Therefore, it would have been obvious to a person of ordinary skill in the art substitute one for another one.

Applicant argues that “the Casas light source, even if combined with Richards, does not provide any teaching that the brake release handle itself be reengineered [sic], as opposed to the approach adapted by Casas of attaching a light externally to a tool such as a chainsaw.” See page 6, lines 17-90 in applicant’s remarks. This argument is not persuasive. It should be noted that claim 1 merely recites, “the light source is secured within the brake release handle.” As stated above, Casas by itself teaches that the light bulb or light source is considered to be located within the handguard or the brake release handle, since the housing of the light bulb is considered to be a part of the handguard or brake release handle which surrounds the light bulb or the light source. In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, Casas’s handle could house the entire light source within a housing, as taught by Richards.

Richards teaches a general concept of securing a light source entirely within a handle. However, a person of ordinary skill in the art is familiar with different methods to incorporate a light source within a handle.

In response to applicant's argument that Richards is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant’s endeavor or, if not, then be

reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Richards reasonably pertinent to the particular technique used in the invention to disposed a light source entirely behind a front wall of a handle.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ghassem Alie whose telephone number is (571)272-4501. The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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A handwritten signature in black ink that reads "Ghassem Alie". The signature is fluid and cursive, with the first name "Ghassem" and the last name "Alie" clearly distinguishable.

Ghassem Alie
Patent Examiner
Art Unit 3724

November 21, 2007